

REMARKS

The Office Action dated April 30, 2009 has been received and carefully considered. In this response, claims 1, 17, 27, and 37 have been amended. No new matter is added. *Since the current amendment to the claims is made only to address the non-statutory subject matter rejection, it is believed that the amendment would not necessitate any new ground of rejection based on prior art.*

Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-40

On pages 2-3 of the Office Action, claims 1-40 were rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. It is asserted that, “since the claims [independent claims 1, 17, 27, and 37] are directed to a process without including another statutory class of invention (i.e. machine, manufacture, or composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.” Applicant respectfully disagrees.

It is believed that the independent claims 1, 17, 27 and 37, as originally presented, already positively recite subject matter of another statutory class. For example, claim 1 recites “creating a bank card including embossed information and magnetic stripe information”; claims 17 and 27 recite “distributing a live credit card and a dead bank card to the customer”; and claim 37 recites “creating a universal bank card including embossed information and magnetic stripe information.” The “bank card” or “universal bank card” with “embossed information and magnetic stripe information,” as well as the “live credit card” and “dead bank card,” undoubtedly

belong in a statutory class and cannot be created or distributed by “mental process” or “human intelligence” alone. Therefore, original claims 1-40 already recited statutory processes.

To the extent that the Examiner is requiring each and every process step to meet the *Bilski* machine-or-transformation test, Applicant respectfully submits that the *Bilski* decision has specifically rejected such a step-by-step analysis

... the [Supreme] Court has made clear that it is inappropriate to determine the patent-eligibility of a claim as a whole based on whether selected limitations constitute patent-eligible subject matter. *Flook*, 437 U.S. at 594 (“Our approach to respondent’s application is, however, not at all inconsistent with the view that *a patent claim must be considered as a whole*.”); *Diehr*, 450 U.S. at 188 (“*It is inappropriate to dissect the claims* into old and new elements and then to ignore the presence of the old elements in the analysis.”). After all, even though a fundamental principle itself is not patent-eligible, processes incorporating a fundamental principle may be patent-eligible. Thus, *it is irrelevant that any individual step or limitation of such processes by itself would be unpatentable under § 101*. See *In re Alappat*, 33 F.3d 1526, 1543-44 (Fed. Cir. 1994) (en banc) (citing *Diehr*, 450 U.S. at 187).

In re Bilski, Slip Op. 2007-1130 at 17-18 (Fed. Cir. 2008) (emphasis added). Therefore, the step-by-step dissection of a process claim is without any legal basis as it has already been rejected by the courts.

Notwithstanding the above, Applicant has amended independent claims 1, 17, 27, and 37 to remove any doubt that these claims are not compliant with §101.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1-40 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1-40

On pages 4-10 of the Office Action, claims 1-22 and 24-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Melchione (U.S. Patent No. 5,930,764) in view of Hall (U.S.

Patent No. 6,158,657). On pages 11-13, claims 27-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jones (U.S. Pub. No. 200410117300) in view of Hall. On pages 13-14, claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Melchione in view of Strock (U.S. Pub No. 200410122736). On pages 14-16, claim 33-36 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jones in view of Strock. On pages 16-18, claims 37-38 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jones in view of Infosino, U.S. Patent No. 6,715,679. These rejections are hereby respectfully traversed.

Regarding claim 1, the Examiner asserts that Melchione and Hall together teach a method for distributing bank cards comprising all the steps as presently claimed. In particular, the Examiner concedes that Melchione does not teach “*wherein the card is a dead bank card*” or “*distributing the dead bank card to the person.*” Office Action at 4. However, it is asserted that Hall teaches these limitations and that it would be obvious to combine Hall with Melchione in order to “minimize risk to credit card issuers and increase the level of response to offers for secured credit card products.” Office Action at 5.

Applicant respectfully submits that the Melchione-Hall combination does not teach or suggest all the elements as recited in claim 1 and therefore cannot render the claimed invention obvious. In particular, the Examiner has misunderstood Hall which does not make any reference to any “dead bank card” or any distribution thereof.

The Specification of the present application describes a dead bank card at paragraph [0030] as follows:

[0030] As referred to herein, “dead” bank cards refer to bank cards which are physically identical to a live bank card (i.e., are embossed or otherwise inscribed with the account holder's name, account number, and the like, and which include the appropriate magnetic stripe data), but which reflect a bank account that is not yet activated because the customer has not accepted the bank's

offer for a new bank account. Therefore, such a bank card is in essence a dead card because the customer did not make an application, and at the time the bank card is distributed the customer has not yet responded positively (customer's acceptance) to the unsolicited overture (bank's offer). The dead bank card is capable of full functionality upon activation because it is distributed to the customer with all necessary information, including a bank account number assigned to that prospective customer before the card is sent.

Nowhere does Hall even mention a dead bank card, let alone the method steps of creating and distributing a dead bank card as presently claimed.

Hall is directed to a system and method for "offering and providing secured credit card products." Hall: Abstract. As cited in the Office Action, Figures 2 and 3 of Hall describe the process of offering secured credit card products to selected customers, screening the responses to the offers, and issuing new cards to approved customers. In Hall's process, the initial communication with a potential customer is an offer of a secured credit card product -----

"After determining the type of product to offer each potential customer, the issuer sends the offers to the list of potential customers (step S.30). *The offers that are sent to potential customers may be sent in the form of solicitation or offer letters through the mail and/or they may be electronically transmitted (e.g., by e-mail) to the potential customers on the list.* The sending of offers may be carried out by the credit card issuer or may be performed by a third party contracted by the credit card issuer."

Hall: col. 9, lines 6-14 (emphasis added). It should be noted that Hall does not indicate whether a dead bank card or a dead credit card is created and distributed to a potential customer with the initial offer sent "through the mail." Since Hall never mentions a dead bank card or any card that needs activation, it is very unlikely that Hall intended or suggested a distribution of a dead bank card with the initial offer. Also, based on the fact that the offers "may be *electronically transmitted* (e.g., by e-mail)," it is likely that Hall did not intend to send any physical card with

the offers. Indeed, from the content of Hall's subsequent communications with a customer who has responded to the initial offer and become approved for a new card, it is apparent that no bank card (dead or alive) is included with the initial offer —

“As further illustrated in FIG. 3, after determining the credit limit for a customer, a customer account is set-up and established (step S.60). The customer account may be set-up by computing platform 300 based on the credit limit determined for the customer. As part of this process, information relating to the account (e.g., customer name, address, account number, credit limit, etc.) may be stored in database 600 by computing platform 300. A credit card in the form of a plastic-card like member may also be generated by the credit card issuer. Following step S.60, the customer is notified of their new account information, including the determined credit limit of the secure credit card product associated with the account (step S.70). Notification to each customer may be sent through the mail and/or include an electronic notification message (such as an e-mail). Notification may also include providing one or more plastic credit card members associated with the customer's account for conducting transactions and purchases.”

Hall: col. 9, line 60 – col. 10, line 10 (emphasis added). The above-quoted passage makes it abundantly clear that both the creation and distribution of a credit card in Hall's process occur after the customer has responded to the initial offer and has been approved for a new secured credit card. This means that no card was previously distributed to the customer with the initial offer. Otherwise, it would be redundant and wasteful to send a second card to the same customer. Also, if a new account is to be created and a new card generated only after a customer accepts the offer and has been approved, it would be unnecessary to send that customer a dead card in the first place.

For the foregoing reasons, claim 1 should be patentable over Melchione and Hall. Claims 2-16, which all depend from claim 1, should also be allowable for at least the same reasons. Furthermore, these dependent claims recite additional features not disclosed by Melchione. For

example, Melchione does not teach or suggest “*wherein the pool is identified based on the region or regions served by the bank issuing the new bank accounts*” as recited in claim 2. The portion of Melchione cited against claim 2, i.e., column 9, lines 46-51, which describes distribution of marketing leads to personal bankers within the branch, has no relevance to the selection of potential new account holders within a bank’s service region(s) (“footprint”). For another example, Melchione does not teach or suggest “*prebuilding an account if the person is determined to be eligible, thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person*” as recited in claim 14. The passages of Melchione cited against claim 14 (i.e., col. 7, lines 59-67 to col. 8, lines 1-7 and col. 9, lines 53-64) merely describes the collection of customer information and providing such information to personal bankers. Nowhere does Melchione suggest prebuilding an account before a potential customer becomes an account-holder.

In rejecting claim 17, the Examiner concedes that Melchione does not teach “*distributing a live credit card and a dead bank card to the customer ...*” (Office Action at 7), but the Examiner points to Figures 2 and 3 and the Abstract of Hall as disclosing the same. As discussed above in connection with claim 1, the Examiner has misunderstood Hall which never mentions “a dead bank card” at all. Nor does Hall teach or suggest distributing both a live credit card *and* a dead bank card to a customer. Hall only teaches distributing a live (secured) credit card to the customer. Since the Melchione-Hall combination fails to teach or suggest “*distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder*” as recited in independent claim 17, the cited references cannot render claim 17 or its dependent claims 18-26 obvious. Therefore, claims 17-26 should be patentable over the cited references.

Regarding claim 27, the Examiner asserts that Jones and Hall together teach a method of distributing solicited credit cards and unsolicited bank cards comprising the same steps as presently claimed. Applicant respectfully submits that the Jones-Hall combination does not teach or suggest all the elements as recited in claim 27 and therefore cannot render the claimed invention obvious.

In particular, Hall does not teach or suggest “*distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder*” or “*processing a customer response to the dead bank card,*” which limitations are admittedly not disclosed by Jones (Office Action at 11). As in the rejections of claims 1 and 17, the Examiner cites the same portions from Hall (Figures 2 and 3 and Abstract) as allegedly disclosing the claim elements related to a dead bank card. However, these or other portions of the Hall reference do not teach or suggest “a dead bank card” as presently claimed. There is simply no evidence suggesting that Hall would distribute dead cards to potential customers prior to their acceptance of card offers.

For the foregoing reasons, claim 27 should be patentable over Jones. Claims 27-36, which all depend from claim 27, should also be allowable for at least the same reasons.

Regarding claim 37, the Examiner asserts that the combination of Jones and Infosino teaches a method of distributing bank cards by a sponsoring bank comprising the same steps as presently claimed. Applicant respectfully submits that the Jones-Infosino does not teach or suggest all the elements as recited in claim 37 and therefore cannot render the claimed invention obvious.

At least, the cited references fail to disclose “*the universal bank card including a universal bank account number to be associated by the person with an existing bank account*”

held by a bank other than the sponsoring bank” or “distributing the universal bank card to the person [where the person is identified for distributing an unsolicited offer for a universal bank account card]” as recited in claim 37 (emphasis added).

The Examiner concedes that Jones does not disclose a universal bank card (Office Action at 17) but cites the Abstract and col. 2, lines 1-25 from Infosino as allegedly disclosing a universal bank card. However, despite including the same term “universal,” Infosino’s “universal card” is quite different from the “universal bank card” presently claimed. Infosino’s “universal card” is essentially a card emulator programmable to mimic pre-existing cards, such that the physical characteristics of the universal card would cause card readers to believe the card to be identical to the cards emulated. Infosino’s “universal card” is not distributed to a customer as an unsolicited offer and does not have “a universal bank account number” that can be “associated ... with an existing bank account held by a bank other than the sponsoring bank” as presently claimed. Like Jones, Infosino simply makes no reference to a universal bank card concept as Infosino never mentions linking a card to an account that is not held with the issuer.

For the foregoing reasons, claim 37 should be allowable over Jones. Claims 38-40, which all depend from claim 37, should also be allowable for at least the same reasons.

Regarding claims 23, 33-36, and 39 (which ultimately depend from claims 17, 27, and 37 respectively), the Office Action rejected these claims without citing either Hall or Infosino for the alleged disclosure of “a dead bank card” or “a universal bank card” respectively. Therefore, the rejections of claims 23, 33-36, and 39 are defective. In any case, these claims should be patentable over the cited references for at least the reasons why their respective independent claims are patentable.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-40 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue. if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account No. 07-1700, and please credit any excess fees to the same deposit account.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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